

Remarks

Reconsideration of this Application is requested. Claims 17-32 are currently pending in this application. Claim 34 has been cancelled without prejudice.

The claims stand rejected as follows:

- A. Claims 17-32 stand rejected under 35 USC 103 as being obvious over U.S. Patent No. 6,438,583 to McDowell et al. (the '583 patent) in view of U.S. Patent No. 5,805,810 to Maxwell (the '810 patent) in further view of U.S. Patent No. 6,075,844 to Goldberg et al. (the '844 patent); and
- B. Claim 34 stands rejected under 35 USC 103 as being obvious over the '583 patent in view of U.S. Patent No. 6,405,243 B1 to Nielsen (the '243 patent).

The above 35 USC 103 rejection of claim 34 is now moot in view of the cancellation of claim 34.

Independent claim 17 recites the following recitation:

Receiving the e-mail message at an intermediate address, the e-mail message including non-preferred e-mail address data, the e-mail message having been previously transmitted to an invalid e-mail address and transmitted back to a sender e-mail address.

Thus: 1) an email is transmitted from a sender's PC; 2) rejected at a non-preferred PC; 3) send back to the senders PC and 4) then send to an intermediate address. Independent claims 24, 31 and 32 recite a similar recitation.

In formulating the 35 U.S.C. 103 rejection of the '583 patent in view of the '810 patent and in further view of the '844 patent, the examiner states: "[the '583 patent] in view of [the '810 patent] fails to teach wherein the e-mail message having been previously transmitted to an invalid e-mail address and transmitted back to a sender e-mail address. [The '844 patent] teaches wherein the e-mail

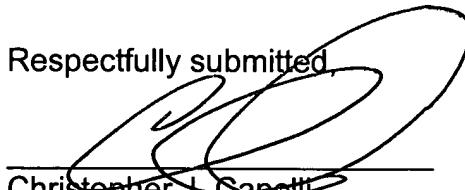
message having been previously transmitted to an invalid e-mail address and transmitted back to a sender e-mail address (See col. 7, lines 30-36). It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the e-mail message is transmitted back to a sender e-mail address as taught by [the '844 patent] in the claimed invention of [the '583 patent] in view of [the '810 patent] in order to for the sender to determine whether the message was correctly sent to the intended recipient (See col. 7, lines 11-12)."

It is respectfully submitted that the '844 patent does not overcome the noted deficiencies of the '583 and '810 patents. A proper reading of the '844 patent reveals that it neither teaches nor suggests processing a rejected e-mail that was returned from a recipient's PC. For instance, with respect to col. 7, lines 11-12 of the '844 patent, what is actually taught is that when a sender's PC sends a message to a recipient, it also sends a message back to the sender "so the sender is able to determine whether the message was correctly sent to the intended recipient." In other words, did the sender's PC correctly identify who the intended recipient is. This has nothing to do with an "e-mail message having been previously rejected at the non-preferred e-mail address." Similarly, with respect to col. 7, lines 30-36 of the '844 patent, what is actually taught is that the system sends a message back to the sender that it "is not able to determine who the recipient for the message is because either the speech recognition software could not recognize the identification information . . . or no routing access code was contained in the database for the intended recipient . . ." In this instance, clearly no email message was ever transmitted because it did not know who to send it to.

Simply put, the '844 patent does not teach or suggest of processing rejected previously transmitted e-mail messages and thus does not overcome the noted shortcomings of the '583 and '810 patents. Accordingly, it is submitted that Claims 17-32 are allowable over the '583 patent in combination with the '810 and '844 patents.

In view of the foregoing remarks, it is respectfully submitted that pending claims 17-32 are in condition for allowance and favorable action thereon is requested. If the Examiner should have any questions, he is kindly urged to contact the undersigned attorney.

Respectfully submitted,


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